

PCT

Docket No.: 30980088US

PATENT #5-

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Maurizio PILU

Serial No.: 09/786,825 ✓

Art Unit: Not Known

Filed: March 9, 2001

Examiner: Not Known

For: DOCUMENT IMAGING SYSTEM

Attn: PCT Legal Office  
Box PCT  
Commissioner for Patents  
Washington, D.C. 20231

**RECEIVED**

29 MAR 2002

Legal  
International Division

Dear Sir:

**RESPONSE TO DECISION ON REQUEST TO WITHDRAW HOLDING OF  
ABANDONMENT AND PETITION UNDER 37 CFR §1.182**

( This response is filed based on the DECISION ON REQUEST TO WITHDRAW  
HOLDING OF ABANDONMENT AND 37 CFR 1.182 ("DECISION"), dated March 4, 2002.  
Below is presented the points to be reviewed, a statement of the facts involved, remarks, and the  
action requested.

**Points to be Reviewed**

2 Whether the basic national fee in this application should be deemed paid as of March 9,  
2001, even though the United States Patent and Trademark Office (USPTO) failed to properly  
charge the Applicant's deposit account, and thus whether a holding of abandonment for failure to  
pay should be withdrawn.

### Statement of the Facts

3 The Appendix of this document sets forth a summary of facts in the record of the subject patent application. Applicant wishes to highlight the following item: The USPTO properly charged Applicant's deposit account in an application filed on the same day as the subject application, 09/786,768 ('768), which is formally identical to the subject application. Like the '768 application, the national stage papers originally filed in the subject application included a properly executed assignment and recordation cover sheet, both listing the Hewlett-Packard Company (HP).

### Remarks

4 Applicant asserts that the basic national fee in this application should be deemed paid as of March 9, 2001, for several reasons. First, the USPTO should have charged the HP deposit account in this application based on the undersigned counsel's actual and apparent authority. Second, it is against the policy of the USPTO to ignore such authority and to ignore the indications of the undersigned counsel's affiliation with HP. Third, the USPTO debited the basic national fee from HP's deposit account on August 20, 2001, and the USPTO cashed a check for the basic national fee on August 21, 2001, which is evidence that the undersigned counsel was in fact authorized to have HP's deposit account properly charged as of the filing of this application.

5 First, payment of the basic national fee was actually and apparently authorized. The undersigned counsel had actual authority to charge the HP deposit account at the time of filing the subject application on March 9, 2001, as evidenced by the previously submitted affidavit of HP counsel, Jeffrey Fromm. Also, the undersigned counsel had apparent authority to charge the HP deposit account as manifested by the HP information provided in the national stage papers and specifically listed on the assignment and the assignment recordation cover sheet. Applicant points to the Discussion section on page 2 of the DECISION, the second paragraph of which states:

The Hewlett-Packard Company's Deposit Account may be charged the basic national fee provided that the transmittal letter states that the attorney is working on behalf of Hewlett-Packard. However a review of the transmittal letter did not indicate that counsel had any affiliation with Hewlett-Packard. Accordingly...applicants had no apparent authorization.

6 The transmittal letter, however, is not the only way to provide an indication of counsel's affiliation with an assignee in order to authorize charging the assignee's deposit account. In addition to the formally identical '768 application that was filed the same day as the subject application, there was filed a similar HP national stage application, U.S. Ser. No. 09/869,421 ('421). In the '421 application, like the '768 application, the HP deposit account was properly charged even though the transmittal letter did not indicate the undersigned counsel's affiliation with HP. In regard to the '421 application the DECISION states in the last paragraph on page 2,

A review of 09/869,421 reveals that the fees were properly charged in that application despite the fact that the transmittal letter did not show that the patent application was for the Hewlett-Packard Company. The declaration filed with the national stage papers listed the Hewlett-Packard Company, but the same information was not provided on the declaration in the [subject] application.

HP was, however, listed on the assignment and recordation cover sheet in the subject application. Thus, the "same information" was in fact provided in both the subject application and in the '768 application.

7 If the indication of HP - as manifested on the declaration - was sufficient to properly charge the fees in the '421 application, then the indication of HP - as manifested on the assignment and recordation cover sheet - was likewise sufficient to properly charge the fees in this application. In other words, if the declaration of the '421 application provided the requisite indication of counsel's affiliation with, and apparent authorization of HP, then the assignment filed in this subject application also provided the requisite indication of affiliation with, and apparent authorization of HP. In fact, the USPTO did so recognize the undersigned's affiliation with HP, and apparent authorization of HP, when the USPTO charged the recordation fee for the assignment in the subject application on March 9, 2001. Therefore, it is arbitrary and unreasonable for the USPTO to now find that a declaration can provide sufficient indication of counsel's affiliation with an assignee, but that an assignment itself cannot.

8 An assignment is, in fact, capable of indicating counsel's affiliation with an assignee to enable the USPTO to properly charge HP's deposit account. As the record reflects, the '768 application was filed on March 9, 2001, the same day as the subject application. The '768 filing was formally identical to the filing of the subject application in that they both included transmittals and declarations that did not list the HP correspondence address, but both included assignments that did list the HP correspondence address. In the '768 application, however, the USPTO correctly charged the basic national fee to the HP deposit account and a Notification of

Acceptance of Application was mailed on April 16, 2001, expressly stating that the U.S. basic national fee was received. Given the identical nature of the filings, the HP deposit account should have been charged in the subject application just as it was in the '768 application, and any opposite result would be arbitrary and unreasonable.

9 Second, traditionally the USPTO has relied upon the registered practitioner's duty of candor and good faith, and has accepted as certified all signed documents submitted by registered attorneys and agents. In fact, this practice is codified in 37 CFR §1.34. According to 37 CFR §1.34 (a):

When a registered attorney or agent acting in a representative capacity appears in person or **signs a paper** in practice before the Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the Patent and Trademark Office that...**he or she is authorized to represent** the particular party in whose behalf he or she acts. (Emphasis added.)

The USPTO's decision to deny the signatory authority of the undersigned attorney, and thereby fail to charge HP's deposit account, appears to be in direct conflict with this rule.

10 Under 37 CFR §1.34, the undersigned's submission of subject application '825 together with a signed cover sheet charging the payment of fees from HP's deposit account, should have been enough authorization for the USPTO to withdraw the required funds. Furthermore, the undersigned also submitted the above-mentioned assignment, clearly listing HP as the assignee, and an Information Disclosure Statement (IDS) on HP letterhead. Both of these documents provided further indication of the authority of the undersigned with respect to the HP deposit account. However, the USPTO failed to recognize the undersigned's authority. The USPTO's disregard of the undersigned's authority was especially egregious, in view of the Assignment and the IDS, which provided full corroboration and indication of the undersigned's affiliation with HP.

11 Furthermore, the non-acceptance of the undersigned's signed authority is contradictory to USPTO customer service policy. The USPTO has sought to improve customer relations, especially in dealings with registered practitioners. This general policy is exemplified in the USPTO's granting of examiner interview to registered practitioners in instances where the registered practitioner is not of record. These interviews are granted on good faith, to any registered agent or attorney who has a copy of the application file. (See MPEP § 713.05.) In accordance with this known USPTO policy, the undersigned's authorization to charge the HP deposit account should have been recognized.

12  
Third, the basic national fee should be deemed timely paid because in fact, the fee has already been paid - not once, but twice. On August 20, 2001, the USPTO charged HP's deposit account no. 08-2025, the U.S. basic national fee of \$860.00, for the subject application (09/786,825). On August 21, 2001, the USPTO also cashed an \$860.00 check submitted with the petition dated August 15, 2001, for payment of the same basic national fee.

In summary, the holding of abandonment of the subject application should be withdrawn as a matter of undisputed facts, applicable law, and sound policy. The basic national fee in the subject application has, in fact, already been paid. Also, the USPTO should stand behind its good faith presumption of signatory authority pursuant to 37 CFR §1.34. Finally, the undersigned counsel had actual and apparent authorization to charge the HP deposit account no. 08-2025 at the time of filing the subject application. Therefore, the basic national fee in the subject application should be deemed paid and the holding of abandonment of this application should be withdrawn.

Action Requested

Applicant respectfully requests reconsideration on the merits of the petition to withdraw the holding of abandonment and of the petition under 37 CFR §1.182. Specifically, Applicant respectfully requests that the finding of Abandonment for U.S. Patent Application No. 09/786,825 be withdrawn and a Notification of Acceptance of Application be issued.

Also, please apply a credit of \$860.00 to our deposit account no. 50-1656 for the duplicate payment of the basic national fee, as discussed in detail in the Appendix. A copy of the \$860.00 check as endorsed and cashed by the USPTO on August 21, 2001 is attached herewith.

Respectfully submitted,

Date: March 22, 2002

John W. Ryan  
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Encl: Appendix A (2 pages) Summary of Facts

Appendix B (2 pages) Copy of August 21, 2001 cancelled check for \$860.00

## Appendix A

### Summary of Facts

On July 7, 2000, Applicant Hewlett-Packard (HP) filed PCT/GB00/02621 claiming priority to a British patent application with a filing date of July 9, 1999. No Demand for an international preliminary examination was filed and, as a result, the twenty-month period for paying the national fee in the United States was extended until March 9, 2001.

On March 9, 2001, Applicant filed for entry into the national stage in the United States under 35 U.S.C. §371 for PCT/GB00/02621 and was assigned serial no. 09/786,825 ('825). The documents filed included a transmittal letter signed by registered attorney John Ryan (Reg. No. 33,771), an assignment indicating HP as the assignee, an information disclosure statement (IDS) on HP letterhead, and a declaration indicating that correspondence should be sent to John Ryan. The transmittal letter included signed authorization to charge the basic national fee to HP deposit account no. 08-2025.

Also on March 9, 2001, Applicant filed for entry into the national stage in the United States under 35 U.S.C. §371 for a second application, PCT/GB00/02603, serial no. 09/786,768 ('768). The documents filed in the '768 application were identical in form to those filed for subject application '825. In other words, the documents included an assignment indicating HP as the assignee, an IDS on HP letterhead, and a declaration indicating that correspondence should be sent to John Ryan. The transmittal letter also included authorization to charge the basic national fee to HP deposit account no. 08-2025.

On April 16, 2001 the USPTO mailed a Notification of Acceptance of Application to John W. Ryan for the '768 application, indicating that the U.S. basic national fee had been received (i.e., timely charged to HP's deposit account). No such notification was mailed for the '825 application.

On June 27, 2001, Applicant filed for entry into the national stage in the United States under 35 U.S.C. §371 for a third application, PCT/GB00/04148, serial no. 09/869,421 ('421). The documents filed with the '421 application were similar to those filed for the '825 application on March 9, 2001, including a transmittal letter including authorization by John Ryan to charge the basic national fee to the HP deposit account. Also included were, a declaration, an assignment, and an IDS, all including HP correspondence information.

On July 17, 2001, the USPTO mailed a Notice of Recordation of Assignment in the subject application, thus indicating that the HP deposit account had been charged for the recordation fee since assignments are not recorded without the accompanying fee.

On August 15, 2001, Kaya Baltimore and Katherine Short of the USPTO's PCT Receiving Office telephoned the undersigned to say that the subject application was abandoned due to non-payment of the filing fee. Applicant immediately filed a petition to withdraw the holding of abandonment, along with a \$860.00 check for the basic filing fee, a check of \$130.00 for the petition fee, and an "Affidavit of Authority to Charge Deposit Account."

On August 20, 2001, the USPTO charged HP's deposit account No. 08-2025, the U.S. basic national fee of \$860, for subject application '825.\*

On August 21, 2001, the USPTO also cashed the \$860.00 check submitted with the petition dated August 15, 2001, for payment of the same basic national fee. Thus, the Basic National fee has been paid twice.\*

On September 7, 2001 the USPTO mailed a Notification of Acceptance of Application to John W. Ryan for the third-filed application '421, indicating that the U.S. basic national fee had been received (i.e., charged to HP's deposit account).

On September 11, 2001, the USPTO mailed a Notice of Abandonment in the subject application, based on the Applicant's alleged failure to provide the full U.S. basic national fee by twenty months from the earliest priority date.

On September 17, 2001, Applicant submitted a response to the September 11, 2001 Notification of Abandonment.

On March 4, 2002, the USPTO mailed the Decision on Request to Withdraw Holding of Abandonment and 37 CFR §1.18, to which Applicant responds in this paper.

\* On March 12, 2002, in a telephone conference with Farah of the Deposit Account Department of the USPTO, it was learned that the basic national fee of \$860.00 was charged to the HP deposit account no. 08-2025 on August 20, 2001. Also, the USPTO cashed a check in the amount of \$860.00 to cover the basic national fee that was submitted to the USPTO on August 15, 2001 on August 21, 2001.

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